

REMARKS/ARGUMENTS

Applicants have studied the Office Action dated March 28, 2007 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. In the election filed on February 27, 2007, claims 1-66 and 83-87 were pending. By virtue of this amendment, claims 1-66 and 83-87 are pending. Claims 15 and 19 are amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (1) acknowledged election of claims;
- (2-3) rejected claims 19 and 83 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention;
- (4-5) rejected claims 1-10, 12-15, 18, 20-25, 27-36, 38, 55-57, 66, 83-85, and 87 under 35 U.S.C. § 102(b) as being anticipated by Meeker (U.S. Pat. No. 2,108,206);
- (6) rejected claims 1, 5, 11, 26, and 37 under 35 U.S.C. § 102(b) as being anticipated by Schmitt (U.S. Pat. No. 3,754,555);
- (7) rejected claims 39 and 60 under 35 U.S.C. § 102(e) as being anticipated by Biggs et al. (U.S. Pat. No. 6,599,311);
- (8-9) rejected claims 39-54, 58, 59, 61-65, and 86 under 35 U.S.C. § 103(a) as being unpatentable over Meeker (U.S. Pat. No. 2,108,206) in view of Green (U.S. Pat. No. 5,928,137);
- (10) indicated that claims 16 and 17 would be allowable if rewritten in independent form including all of the base claims and any intervening claims; and
- (11) indicated that claim 19 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 and rewritten in independent form including all of the base claims and any intervening claims.

(1) Acknowledged Election of Claims

The Applicants wish to thank Examiner Woo for acknowledgment of Applicant's election of claims 1-66 and 83-87.

(2-3) Rejection under 35 U.S.C. §112

The Examiner rejected claims 19 and 83 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Specifically, the Examiner stated that "said shim" in claim 19 and "said actuator" in claim 83 lack antecedent basis.

Applicants have amended claims 19 and 83 to provide antecedent basis for the shim and actuator elements. No new matter was added.

In view of the amendment to claims 19 and 83, Applicants believe that the rejection of claims 19 and 83, under 35 U.S.C. § 112, second paragraph, has been overcome.

Applicants request that the Examiner withdraw the rejection of claims 19 and 83.

(4-5) Rejection under 35 U.S.C. §102(b) Meeker

As noted above, the Examiner rejected claims 1-10, 12-15, 18, 20-25, 27-36, 38, 55-57, 66, 83-85, and 87 under 35 U.S.C. § 102(b) as being anticipated by Meeker (U.S. Pat. No. 2,108,206). The claims have not been amended to overcome the cited prior art.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Independent claim 1 recites, *inter alia*:

flexible needles of a **shape memory material** having a **memory shape**, said needles connected to said connector, said **memory shape** of said needles including a portion with an **arcuate shape**. (emphasis added)

SYN-8312

17 of 24

10/728,389

Claim 1 provides that the flexible needles are "of a shape memory material having a memory shape." By definition this feature **cannot** have been disclosed by Meeker because it was not invented until decades after the issuance of Meeker.

In the rejection of claim 1, the Examiner states "two, flexible needles (4a and 4b) of shape memory material ('resilient piece of metal')." (Emphasis added by applicants.) Therefore, the Examiner is equating the "resilient" material of the teeth 4a, 4b of Meeker with the "shape memory material" of claim 1 of the instant application. As will be described below, such a comparison cannot be properly made.

The specification clearly describes what a shape-memory material is. Such description can be found, for example, at page 15, lines 5 to 17. In addition, it is hereby submitted that a person having skill in the art knows particular and unique characteristics possessed by a "shape-memory" material as defined in the instant application and in claim 1. Many individuals and companies have made entire careers and fortunes by protecting inventions relating to or including shape-memory materials. A significant number of patents have been issued that pertain to this subject. Many were issued to an inventor named Jervis and three of these patents, for example, were issued as United States Patent Nos. 4,665,906, 5,067,957, and 5,597,378. See specification at 15, lines 8 to 9. These patents describe, in significant detail, the unique properties of shape-memory materials -- materials that are present within claim 1. These patents also indicate that such materials were not invented until almost half a century after Meeker, which issued in 1938. Nonetheless, the Examiner still argues that Meeker actually discloses the shape-memory material by equating it to the "resilient" material of the teeth 4a, 4b of Meeker.

One having ordinary skill in the art of shape-memory materials knows that such materials have entirely different characteristics than the "resilient" metal that was known and envisioned by Meeker in 1938. Further, if one were to accept as valid the equality of shape memory materials and "resilient" metals, then, every single one of the patents relating to shape memory materials should not have issued and would never have

issued, whether in the U.S. or elsewhere. The reason why all of these patents issued was because shape memory materials are not analogous to mere "resilient" metals; they have defined characteristics that are novel and, therefore, are patentable.

Claim 1 includes a retractor applying the shape memory materials as needles. This invention has not been disclosed anywhere in the prior art and, especially, not in Meeker. Thus, applicants have met their burden to show that claim 1 possesses novelty over Meeker.

Independent claim 66 also discloses the same feature of "flexible needles of a shape memory material having a memory shape." Therefore, for the same reasons claim 1 is novel, claim 66 is also novel and possess inventiveness over Meeker and the respective rejection must be withdrawn.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.¹ Because the elements in independent claims 1 and 66 of the instant application are not taught or disclosed by Meeker, the apparatus of Meeker does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 1 or 66. Accordingly, the present invention distinguishes over Meeker for at least this reason. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(6) Rejection under 35 U.S.C. §102(b) Schmitt

As noted above, the Examiner rejected claims 1, 5, 11, 26, and 37 under 35 U.S.C. § 102(b) as being anticipated by Schmitt (U.S. Pat. No. 3,754,555). The claims have not been amended to overcome the cited prior art.

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

Claim 1 recites that the flexible needles are "of a shape memory material having a memory shape." In the rejection of claim 1, the Examiner states "flexible needles (24) of shape memory material ('resilient' nylon or stainless steel)." (Emphasis added by Applicants.) Therefore, the Examiner is equating the "resilient" nylon or stainless steel with the "shape memory material" of claim 1.

As stated in the section above entitled "(4-5) Rejection under 35 U.S.C. §102(b) Meeker", such comparison is improper and cannot be upheld. Therefore, the above analysis is incorporated herein by reference.

If one were to accept as valid the Examiner's proposition that shape memory materials are equivalent to the "resilient" nylons and stainless steel of Schmitt, then, every single one of the patents relating to shape-memory materials should not have issued and would never have issued, whether in the U.S. or elsewhere. The reason why all of these patents issued was because shape memory materials are not analogous to mere "resilient" nylons and metals; they have defined characteristics that are novel and, therefore, are patentable.

Claim 1 includes a retractor applying the shape memory materials as needles. This invention has not been disclosed anywhere in the prior art and, especially, not in Schmitt. Thus, applicants have met their burden to show that claim 1 possesses novelty over Shmitt.

Because the elements in independent claim 1 of the instant application are not taught or disclosed by Schmitt, the apparatus of Schmitt cannot anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1. Accordingly, the present invention distinguishes over Schmitt for at least this reason. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(7) Rejection under 35 U.S.C. §102(b) Biggs et al.

As noted above, the Examiner rejected claims 39 and 60 under 35 U.S.C. § 102(e) as being anticipated by Biggs et al. (U.S. Pat. No. 6,599,311).

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Independent claim 39 recites, *inter alia*:

flexible needles of a shape memory material having a memory shape, said needles connected to said connector, said memory shape of said needles including a portion with an arcuate shape. (emphasis added)

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claim, each of which the Examiner must specifically point out. In this case, the Examiner does not cite any particular element of Biggs et al. that is supposed to show the shape memory material of claim 39. Applicants submit that this omission is because Biggs et al. do not show and cannot show shape memory material.

Because the elements in independent claim 39 of the instant application are not taught or disclosed by Biggs et al., the apparatus of Biggs et al. does not anticipate the present invention. Dependent claim 60 is believed to be patentable as well because it is dependent on claim 39. Accordingly, the present invention distinguishes over Biggs et al. for at least this reason. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(8-9) Rejection under 35 U.S.C. §103(a) Meeker and Green

As noted above, the Examiner rejected claims 39-54, 58, 59, 61-65, and 86 under 35 U.S.C. § 103(a) as being unpatentable over Meeker (U.S. Pat. No. 2,108,206) in view of Green (U.S. Pat. No. 5,928,137).² The claims have not been amended to overcome

² Applicants make no statement as to whether such a combination is even proper.

the cited prior art.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 39 recites, *inter alia*:

flexible needles of a shape memory material having a memory shape, said needles connected to said connector, said memory shape of said needles including a portion with an arcuate shape. (emphasis added)

Claim 39 provides that the flexible needles are "of a shape memory material having a memory shape." As stated above in the section entitled "(4-5) Rejection under 35 U.S.C. §102(b) Meeker", by definition, shape memory material **cannot** have been disclosed by Meeker because, among other reasons set forth above with respect to claim 1, it was not invented until decades after the issuance of Meeker. The analysis is incorporated by reference herein.

The Examiner goes on to combine the Green reference for the purpose of teaching "a flexible endoscope having a least one working channel for receiving an endoscopic tool" and for no other reason. Therefore, the Examiner does not even allege that Green makes up for the above-mentioned deficiencies of Meeker.

It is accordingly believed to be clear that Meeker, whether taken alone or in any combination with Green neither shows nor suggests the features of claim 39. Claim 39 is, therefore, believed to be patentable over the art. Dependent claims 40-54, 58, 59, 61-65, and 86 are believed to be patentable as well because they all are ultimately dependent on claim 39. Applicants hereby request that the Examiner's rejection be withdrawn.

(10-11) Allowable Subject Matter

The Applicants wish to thank Examiner Woo for indicating the allowable subject matter of claims 16, 17, and 19.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

It is believed that no fee is due with this Amendment. However, if any fees are due with respect to Sections 1.16 or 1.17, please charge to the deposit account of the undersigned firm, Acct. No. 503,836.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

SYN-8312

23 of 24

10/728,389

Respectfully submitted,

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SYN-8312

24 of 24

10/728,389